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10/042,093	01/08/2002	Jon Michael Kleinberg	ARC919970008US2	6570

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EXAMINER

KERZHNER, ALEKSANDR

ART UNIT	PAPER NUMBER
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2162

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09/25/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/042,093	Applicant(s) KLEINBERG, JON MICHAEL	
	Examiner ALEKSANDR KERZHNER	Art Unit 2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed on 04/30/2009 has been received and entered. Claims 1-71 are pending and have been examined. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL.**

Reissue Oath/Declaration

2. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Claims 1-71 are rejected as being based upon a defective reissue declaration under **35 U.S.C. 251** as set forth above. See 37 CFR 1.175.

The supplemental reissue oath/declaration filed on 5/22/2007 had failed to specify the at least one error with explanation. Since the claims are marked as being amended, error indication must clearly state what is being amended and what is being added in the new claims.

The explanation, for example, should state: claim 1, line 5 has been narrowed by adding "recording" to computer-readable medium.

It is required that error be stated clearly and completely, thus citing column, lines no. from the specification is not sufficient.

Examiner notes Applicant's statement that "a corrected reissue declaration is being prepared and will be submitted when it becomes available." However, 37

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CFR 1.175(b) and (c) clearly require a supplemental declaration if any error not covered by the original oath or declaration is later corrected or where all errors that were specifically identified in prior-filed oaths or declarations are no longer being corrected.

Reissue Applications

3. **Claims 58-71** are rejected under **35 U.S.C. 251** as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. *See Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of **35 U.S.C. 251**, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The instant application has broadened the original patent by omitting the recitation of:

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"the steps of: (i) producing first authoritativeness information about a set of information resources pointed to by links in resources of the input set, and (ii) producing second authoritativeness information about a set of information resources having links that point to resources of the input set... produce a final set of information resources based on the first and second authoritativeness information." Examiner notes that the bolded and underlined part was added in an amendment dated March 16, 1999. Examiner notes that in the same amendment "results of the final iteration" was replaced with the above quoted phrase and in the remarks section, pages 6-11, this amendment was argued to overcome prior rejection.

Omission of "the steps of: (i) producing first authoritativeness information about a set of information resources pointed to by links in resources of the input set, and (ii) producing second authoritativeness information about a set of information resources having links that point to resources of the input set... produce a final set of information resources based on the first and second authoritativeness information" in independent claims 58, 70 and 71 which is now considered to provide the "broadening aspect" to the claim(s), and where in the original application the narrowed claim scope was presented/argued to obviate a rejection/objection that lead to its issue as a patent.

Remarks

4. Examiner notes that an offer to surrender the original patent (for which reissue is requested) is no longer required. See 37 CFR 1.178(a) as amended, effective September 21, 2004.

Prior Art Rejections

5. Although no prior art is presented in this action, the claims 1-71 are not in proper condition for allowance until the rejections above have been overcome.

Response to Arguments

6. Applicant's arguments filed on 04/30/2009 have been fully considered but they are not persuasive.

Applicant argues in summary that claims have been materially narrowed in other respects, claims have not been enlarged, and therefore, avoid the recapture rule.

Applicant further states:

In particular, Applicant would point out, for example, that claim 58 recites *"using the initial authoritativeness information as input authoritativeness information, and iteratively refining said initial set of pages and determining authoritativeness information for said refined set of pages; and producing a final set of pages based on authoritativeness information for said refined set of pages"*, which was not included in any of the independent claims of the original patent. Thus, clearly, claim 58 (and similarly, claims 70 and 71) have been materially narrowed in other respects, so that these claims have not been enlarged and therefore, avoid the recapture rule (e.g., see MPEP 1412.02).

Examiner respectfully disagrees. A limitation is said to "materially narrow" the reissue claims if the narrowing limitation is directed to one or more "overlooked aspects" of the invention. A limitation that had been prosecuted in the original patent application is not directed to "overlooked aspects" of the disclosed invention and will not overcome the recapture rejection. See MPEP 1412.02.

Examiner notes that limitation of “*using the initial authoritativeness information as input authoritativeness information*” is nearly identical to limitation claimed in lines 5-6 of claim 1 as originally filed and prosecuted in the original patent.

Examiner further notes that limitations of “*using the initial authoritativeness information as input authoritativeness information and iteratively refining said initial set of pages and determining authoritativeness information for said refined set of pages; and producing a final set of pages based on authoritativeness information for said refined set of pages*” is similar to at least limitations of claims 5-6 as originally prosecuted.

As such the limitations do not materially narrow the claims as they are not directed to an overlooked aspect because similar limitations were already prosecuted in the original patent.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEKSANDR KERZHNER whose telephone number is (571)270-1760. The examiner can normally be reached on Mon-Fri 9:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aleksandr Kerzhner/
Examiner, Art Unit 2162

/John Breene/
Supervisory Patent Examiner, Art Unit 2162